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PATENT

Attorney Docket No: 24122-381

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS : Eugene J. ROLLINS *et al.* CONFIRMATION No.: 9832
SERIAL No. : 09/747,666 EXAMINER : C. Hewitt, II
FILING DATE : December 22, 2000 ART UNIT : 3621
FOR : TRACKING TRANSACTIONS BY USING ADDRESSES IN A COMMUNICATIONS
NETWORK

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Sir:

Transmitted herewith for filing in the present application are the following documents:

1. Transmittal Letter (in duplicate);
2. Appellants' Brief on Appeal Under 37 C.F.R. § 1.192 (in triplicate); and
3. Check in the amount for \$165.00.

Our check for \$165.00 is enclosed covering any required fees. In the event any variance exists between the amount enclosed and the Patent and Trademark Office charges, please credit the difference to our Deposit Account 50-0311, Reference No. 24122-381. A duplicate copy of this letter is enclosed for that purpose.

If the enclosed papers are considered incomplete, the Mail Room is respectfully requested to contact the undersigned at (703) 464-4806.

Dated: June 21, 2004

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Attorney Docket No.: 24122-381
: :
Eugene J. ROLLINS *et al.* : Group Art Unit: 3621
: :
Serial No.: 09/747,666 : Examiner: C. Hewitt, II
: :
Filed: December 22, 2000 : Confirmation No.: 9832

For: TRACKING TRANSACTIONS BY USING ADDRESSES IN A COMMUNICATIONS
NETWORK

APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. §1.192

The Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed on April 19, 2004, Appellants herewith submit Appellants' Brief on Appeal in triplicate pursuant to 31 C.F.R. §1.192(a).

In accordance with §1.17(c), a check in the amount of \$165.00 representing the small entity fee for filing an Appeal Brief is attached. It is believed that no other fees are due in connection with this submission, however, if it is determined otherwise, Commissioner is authorized to credit any overpayment or charge any deficiencies to the undersigned's account, Deposit Account No. 50-0311.

(1) REAL PARTY IN INTEREST

By virtue of the assignment recorded April 11, 2001 at reel 011680, frame 0858, the real party in interest is E-centives, Inc., a Delaware corporation having its principal place of business in Bethesda, Maryland.

(2) RELATED APPEALS AND INTERFERENCES

Appellants are not aware of any related appeals or interferences.

(3) STATUS OF THE CLAIMS

Claims 1-10, 18-27, and 35-37 are pending in the application. Claims 11-17 and 28-34 have been cancelled. Claims 1, 3-10, 18, 20-27, and 35-37 stand rejected under 35 U.S.C. § 102(e) as allegedly being unpatentable over U.S. Patent No. 6,029,141 to Bezos et al. ("Bezos"). Claims 2 and 19 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bezos in view of U.S. Patent No. 6,532,492 to Presler-Marshall ("Presler-Marshall").

(4) STATUS OF AMENDMENTS

Appellants have not amended the claims subsequent to a Final Office Action dated December 17, 2003.

(5) SUMMARY OF THE INVENTION

The invention includes a novel system and method for modifying addresses in a communications network to meet a specified condition. There is typically a maximum length for uniform resource locators (URLs). The present invention allows the overall size of a URL to be modified so as to not exceed the maximum length.

When an address is received, a check may be performed to determine if the address exceeds the maximum length (Specification, page 9, lines 6-7). An address identifier may be used in place of a portion of the address in the event this maximum length is exceeded (Specification, page 9, lines 6-11). An intermediary (figure 3, reference character 308) may be used to facilitate communications wherein the intermediary may generate a combined address and may make a request for a modified combined address if a specified condition is not met. (Specification, page 9, line 6 - page 10, line 3). The address identifier may indicate an Internet address, web page, person, company, application, or other types of information. A merchant website may use a lookup table or other mapping mechanism to obtain the meaning associated with an address identifier.

(6) ISSUE

The issues on appeal are as follows:

(a) Whether claims 1, 3-10, 18, 20-27, and 35-37 are patentable under 35 U.S.C. § 102(e) over Bezos; and

(b) Whether claims 2 and 19 are patentable under 35 U.S.C. § 103(a) over Bezos in view of Presler-Marshall.

(7) GROUPING OF CLAIMS

All of the pending claims are separately patentable. However, Appellant has grouped claims that recite similar features. Independent claims 1 and 18 stand or fall together. Independent claims 36 and 37, and their dependent claims 3-9 and 20-26 stand or fall together. Dependent claims 2 and 19 stand or fall together. Independent claims 10 and 27 stand or fall together. Independent claim 35 should be separately considered.

(8) ARGUMENT

All of the pending claims are allowable over the references relied upon by the Examiner. Regarding issue 1, claims 1, 3-10, 18, 20-27, and 35-37 are not anticipated by Bezos because Bezos does not disclose all of the features of the claimed invention. Furthermore, the Examiner's assertion that certain claimed features recited in claims 1 and 18 may be ignored is incorrect. Regarding issue 2, the Final Rejection dated December 17, 2003 fails to set forth a prima facie case of obviousness as required for a proper rejection under 35 U.S.C. § 103(a). The Final Rejection fails to show that the applied references, even if properly combined, teach or suggest all of the features of the claimed invention.

A. Rejections Under 35 U.S.C. § 102(e) Anticipated by Bezos

Independent Claims 1 and 18

Examiner's Allegations Regarding "Conditional Limitations" are Incorrect

In an Office Action mailed May 2, 2003, the Examiner applied Bezos to only certain features of claims 1 and 18 and ignored other features of these claims (See Office Action 5/2/03, pp 2-3). During an Examiner Interview on October 21, 2003, the Examiner indicated that claim 1 included "conditional limitations and claim language" that allowed certain claim features to be ignored. As set forth in a response filed on November 3, 2003, Applicants argued that it was improper for the Examiner to ignore these features of claims 1 and 18.

In a Final Office Action mailed December 17, 2003, the Examiner applied Bezos to the claim features that were previously ignored, alleging that these features were disclosed by Bezos. These allegations are incorrect, and will be discussed in detail below. In an Advisory Action mailed 3/31/04, the Examiner recites that "the Examiner did not change the basis for rejecting claims 1 and 18", and recites MPEP § 2106(II)(C) in support of the position that certain claim features may properly be ignored. It is unclear whether the Examiner wishes to maintain this improper position because Bezos was subsequently applied to the previously ignored features. Therefore, Applicants address the issue of whether the features presented using the so-called "conditional limitations" may be properly ignored. Applicants submit that these features cannot be ignored.

All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The Examiner cites MPEP § 2106(II)(C), which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." However, claims 1 and 18 do not merely make suggestions or present optional steps. Claim 1 recites:

determining whether the combined addresses satisfies a particular condition; and
when the combined address does not satisfy the particular condition, performing the steps of:
substituting at least a portion of the combined address

Claim 18 recites similar features in a similar format. These are not optional steps, but rather steps that are to be performed when the combined address fails to satisfy the particular condition. Thus, the Examiner's failure to consider these features in the first Office Action and the Examiner's assertions in the Advisory Action are improper.

Bezos Does Not Disclose All of the Features of the Claimed Invention

Claim 1 recites, among other things, "determining whether a combined address satisfies a particular condition" and "substituting a portion of the combined address when the combined address does not satisfy the particular condition." Claim 18 recites similar features. At least these features are not disclosed by Bezos.

Apparently, the Examiner relies on Figures 6 and 10a of Bezos to disclose these features of claim 1. Figures 6 and 10a merely appear to be renderings of web pages. Neither of these figures discloses "determining whether a combined address satisfies a particular condition" or "substituting a portion of the combined address when the combined address does not satisfy the particular condition." Furthermore, the portions of the specification of Bezos that purportedly describe these figures are silent with regard to "determining whether a combined address satisfies a particular condition" or "substituting a portion of the combined address when the combined address does not satisfy the particular condition."

In the Advisory Action mailed March 31, 2004, the Examiner asserts that certain "features are broad enough to read on mere 'hyperlinking' a process clearly taught by Bezos et al. (figures 6 and 10a; column 11, lines 43-46)." These assertions are not correct. The so called "hyperlinking" process that Bezos allegedly teaches uses fixed "referral links" or addresses that direct a user to a website (or web page) for the product when the product is selected (see Bezos, column 7, lines 20-34 and 52-60). However, the present invention is not a mere "hyperlink", as the Examiner suggests.

The present invention provides a system and method for modifying addresses in a communications network. The addresses are examined to determine whether a particular condition is met, and the addresses are modified if the condition is not met. Bezos does not disclose nor even suggest determining whether a particular condition is met and modifying an address based on this determination.

The Examiner is unable to identify any specific portions of Bezos that disclose these features because these features are not present in Bezos. Rather, the Examiner makes general references to figures that appear to be mere renderings of web pages and alleges that the features of the present invention are disclosed. Neither the figures, the portions of the specification corresponding to the cited figures, nor the specification disclosed the features of the claimed invention. Thus, rejection of claims 1 and 18 under 35 U.S.C. § 102 is improper and must be reversed.

Independent Claims 36 and 37, and dependent claims 3-9 and 20-26

Independent claims 36 and 37 recite, among other things, “determining whether the combined address satisfies a particular condition” and “substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition.” At least these features are not disclosed by Bezos. As described above, Bezos does not disclose determining whether a particular condition is met in an address or modifying the address if the condition is not met. At best, Bezos discloses fixed hyperlinks with fixed addresses (see Bezos, column 7, lines 20-34 and 52-60). Because each and every element of claims 36 and 37 are not disclosed by Bezos, as is required for rejections based on 35 U.S.C. § 102, these claims are not anticipated by Bezos. Thus, rejection of claims 36 and 37 must be reversed.

Dependent claims 3-9 and 20-26 depend from and add additional features to one of independent claims 36 and 37. Thus, at least by virtue of their dependency, claims 3-9 and 20-26 are also not anticipated by Bezos.

Independent claims 10 and 27

Claims 10 and 27 recite, among other things “receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition.” Bezos does not disclose receiving a modified combined address, nor does Bezos disclose that any address received satisfies a particular condition. The Examiner refers to Figure 4 of Bezos for teaching these features. However, Figure 4 illustrates an address format for a fixed web address or “referral link” (see Bezos, column 11, lines 1-3). At best, this web address is passed to a merchant website for enabling the purchase of a referenced product. The Examiner makes no effort to identify a specific portion of Bezos for disclosing that the received address meets a particular condition because Bezos does not make such a disclosure. Thus, for at least this reason, claims 10 and 27 are not anticipated by Bezos.

Independent Claim 35

Independent claim 35 recites, among other things, “an intermediary that generates ... a modified request ... wherein the modified request ... includes a modified combined address wherein *the modified combined address satisfies a particular condition* ... and wherein the *combined address does not satisfy the particular condition*.” At least these features are not anticipated by Bezos. Again, the Examiner has made general reference to several figures in Bezos and alleges that the features of the present invention are disclosed. Specifically, the Examiner has copied substantially the claim language and appended a reference to figures 1, 2, and 4-9 of Bezos. However, none of the figures cited by the Examiner, nor the specification of Bezos, disclose generating a modified request for a modified combined address that satisfies a particular condition where the combined address does not satisfy the condition. In fact, Bezos does not disclose any addresses meeting a particular condition. Thus, for at least this reason, claim 35 is not anticipated by Bezos.

B. Rejection of Claims 2 and 19 Under 35 U.S.C. § 103(a) Over Bezos and Presler-Marshall

Requirements for prima facie case of obviousness

As stated in the MPEP § 2143, three requirements must be met to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). The requirements are: (1) the prior art must teach or suggest all the features of the claimed invention, (2) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine reference teachings, and (3) there must be a reasonable expectation of success.

Appellant respectfully submits that at least the first requirement is not met by the asserted rejections. Therefore, Appellant examines this requirement in further detail.

All of the features of the claimed invention must be taught or suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 2 and 19 depend from and add additional claims 36 and 37, respectively. Thus, for at least this reason, claims 2 and 19 are patentable over the references relied on by the Examiner. In addition, claims 2 and 19 each recite:

wherein the combined address satisfies the particular condition if a first size of the combined address does not exceed a specified size, wherein the combined address does not satisfy the particular condition if the first size of the combined address does exceed the specified size, and wherein the modified combined address satisfies the particular condition if a second size of the modified combined address does not exceed the specified size.

The Examiner admits that Bezos does not disclose “combined addresses satisfying particular size criteria” (12/17/03 Office Action, p 5) and relies on Pressler-Marshall to overcome this deficiency. However, neither Bezos nor Pressler-Marshall, alone or in combination teach or suggest determining whether a first size of the combined address does or does not exceed a specified size. Pressler-Marshall describes a cache admittance

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protocol having both an *object cache for containing information to be cached* and an *address cache*. A received object (information unit) is received having an address associated with it. A determination is then made as to whether the *size of the candidate object exceeds a predetermined criteria* (Pressler-Marshall, figure 3; column 8, lines 17-33). At best, Presler-Marshall disclose determining whether an object meets certain criteria. No determination is made of whether an *address* meets a certain criteria. Thus, for at least this additional reason, claims 2 and 19 are patentable over the references relied upon by the Examiner.

(9) APPENDIX


The pending claims are attached in the Appendix.

CONCLUSION

It is believed that no fees are due in connection with filing this Appeal Brief other than those provided for elsewhere. In the event that it is determined that fees are due, however, the Commissioner is hereby authorized to charge the undersigned's Deposit Account No. 50-0311.

Respectfully submitted,

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Date: June 21, 2004

APPENDIX

1. **(Original)** A method for modifying addresses in a communications network, the method comprising the computer-implemented steps of:

receiving, at an intermediary, a request for an object that is associated with a server;

generating, at the intermediary, a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request;

determining whether the combined address satisfies a particular condition; and

when the combined address does not satisfy the particular condition, performing the steps of:

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition,

generating, at the intermediary, a modified request that is based upon the request and that includes the modified combined address, and

sending the modified request to the server.

2. **(Previously Presented)** The method of Claim 36, wherein the combined address satisfies the particular condition if a first size of the combined address does not exceed a specified size, wherein the combined address does not satisfy the particular condition if the first size of the combined address does exceed the specified size, and wherein the modified combined address satisfies the particular condition if a second size of the modified combined address does not exceed the specified size.

3. **(Previously Presented)** The method of Claim 36, wherein the step of substituting at least the portion of the combined address data with one or more address identifiers comprises the step of:

substituting at least one address identifier for the intermediary address.

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substituting at least one address identifier for the intermediary address.

4. **(Previously Presented)** The method of Claim 36, wherein the step of substituting at least the portion of the combined address data with one or more address identifiers comprises the step of:

substituting at least one address identifier for the object address.

5. **(Previously Presented)** The method of Claim 36, further comprising the step of:

selecting the one or more address identifiers based upon at least one attribute of the request for the object.

6. **(Previously Presented)** The method of Claim 36, further comprising the step of:

selecting the one or more address identifiers based upon at least one attribute of the object.

7. **(Previously Presented)** The method of Claim 36, further comprising the step of:

selecting the one or more address identifiers based upon at least one attribute of the server.

8. **(Previously Presented)** The method of Claim 36, wherein the request is received from a first participant of a transaction, wherein the transaction is between the first participant and a second participant, and wherein the second participant is associated with the server.

9. **(Original)** The method of Claim 8, wherein the first participant is a customer, the second participant is a merchant, and the transaction is a purchase by the customer from the merchant via a shopping application associated with the intermediary.

10. **(Original)** A method for analyzing addresses, the method comprising the computer-implemented steps of:

receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition, wherein the modified combined address includes one or more address identifiers such that the modified combined address does satisfy the particular condition, and wherein the one or more address identifiers represents at least a portion of the combined address; and

interpreting the one or more address identifiers based upon a mapping between the one or more address identifiers and the portion of the combined address that is represented by the one or more address identifiers.

11-17. (Previously Cancelled)

18. (Original) A computer-readable medium for modifying addresses in a communications network, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving, at an intermediary, a request for an object that is associated with a server;

generating, at the intermediary, a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request;

determining whether the combined address satisfies a particular condition; and
when the combined address does not satisfy the particular condition, performing the steps of:

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition,

generating, at the intermediary, a modified request that is based upon the request and that includes the modified combined address, and

sending the modified request to the server.

19. **(Previously Presented)** The computer-readable medium of Claim 37, wherein the combined address satisfies the particular condition if a first size of the combined address does not exceed a specified size, wherein the combined address does not satisfy the particular condition if the first size of the combined address does exceed the specified size, and wherein the modified combined address satisfies the particular condition if a second combined address does not exceed the specified size.

20. **(Previously Presented)** The computer-readable medium of Claim 37, wherein the step of substituting at least the portion of the combined address data with one or more address identifiers further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

substituting at least one address identifier for the intermediary address.

21. **(Previously Presented)** The computer-readable medium of Claim 37, wherein the step of substituting at least the portion of the combined address data with one or more address identifiers further comprises instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

substituting at least one address identifier for the object address.

22. **(Previously Presented)** The computer-readable medium of Claim 37, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the steps of:

selecting the one or more address identifiers based upon at least one attribute of the request for the object.

23. **(Previously Presented)** The computer-readable medium of Claim 37, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

selecting the one or more address identifiers based upon at least one attribute of the object.

24. **(Previously Presented)** The computer-readable medium of Claim 37, further comprising instructions which, when executed by one or more processors, cause the one or more processors to carry out the step of:

selecting the one or more address identifiers based upon at least one attribute of the server.

25. **(Previously Presented)** The computer-readable medium of Claim 37, wherein the request is received from a first participant of a transaction, wherein the transaction is between the first participant and a second participant, and wherein the second participant is associated with the server.

26. **(Original)** The computer-readable medium of Claim 25, wherein the first participant is a customer, the second participant is a merchant, and the transaction is a purchase by the customer from the merchant via a shopping application associated with the intermediary.

27. **(Original)** A computer-readable medium for analyzing addresses, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving a modified combined address, wherein the modified combined address is based on a combined address that does not satisfy a particular condition, wherein the modified combined address includes one or more address identifiers such that the modified combined address does satisfy the particular condition, and wherein the one or more address identifiers represents at least a portion of the combined address; and

interpreting the one or more address identifiers based upon a mapping between the one or more address identifiers and the portion of the combined address that is represented by the one or more address identifiers.

28-34. **(Previously Cancelled)**

35. **(Original)** A system for modifying addresses in a communications network, the system comprising:

a server that is associated with an object; and

an intermediary that generates, in response to a request for the object received by the intermediary, a modified request to be sent to the server, wherein the modified request is based on the request and includes a modified combined address, wherein the modified combined address satisfies a particular condition by including one or more address identifiers that are substituted for at least a portion of a combined address, wherein the combined address identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request, and wherein the combined address does not satisfy the particular condition.

36. **(Previously Added)** A method for modifying addresses in a communications network, the method comprising the computer-implemented steps of:

receiving, at an intermediary, a request for an object that is associated with a server;

generating, at the intermediary, a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request;

determining whether the combined address satisfies a particular condition;

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition;

generating, at the intermediary, a modified request that is based upon the request and that includes the modified combined address; and

sending the modified request to the server.

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37. **(Previously Added)** A computer-readable medium for modifying addresses in a communications network, the computer-readable medium carrying one or more sequences of one or more instructions which, when executed by one or more processors, cause the one or more processors to perform the steps of:

receiving, at an intermediary, a request for an object that is associated with a server;

generating, at the intermediary, a combined address that identifies both an intermediary address associated with the intermediary and an object address that is determined based on the request;

determining whether the combined address satisfies a particular condition;

substituting at least a portion of the combined address with one or more address identifiers to create a modified combined address, wherein the modified combined address satisfies the particular condition;

generating, at the intermediary, a modified request that is based upon the request and that includes the modified combined address; and

sending the modified request to the server.

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